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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yves Maetz

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EXAMINER

CHOKSHI, PINKAL R

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,146	<b>Applicant(s)</b> MAETZ ET AL.	
	<b>Examiner</b> PINKAL CHOKSHI	<b>Art Unit</b> 2425	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-27 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/09/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 09/26/2008 with respect to claim 15 have been considered but are moot in view of the new ground(s) of rejection. Regarding claim 17, Applicant asserts that Maruyama does not teach of using the points earned into multiple accounts. Examiner disagrees. Maruyama discloses (§0077) that the user applies his/her accumulated points to purchase an item A and uses the remaining point to purchase a second item B as represented in Fig. 16. Maruyama further discloses (§0097) that the points are easily utilized to receive multiple services as represented in Fig. 12. The rejection is maintained. See the new rejection below.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 29** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 29 is claiming a computer program product and as mentioned in paragraph (0051), computer program product consists of a signal.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2425

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 15, 16, 20-27, and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7,389,522 to Shintani et al (hereafter referenced as Shintani) in view of US Patent 6,020,883 to Herz et al (hereafter referenced as Herz).

Regarding **claim 15**, “acquisition device for obtaining files by accumulating points, designed for at least one user of at least one receiver of data of at least one communication network” reads on the device that displays commercial, where viewers earn points for watching commercials (abstract) disclosed by Shintani and represented in Fig. 2.

As to “said user being able to earn points by occurrences of at least one predefined operation accomplished by said user” Shintani discloses (col.3, lines 54-59) that when viewer responds to the commercial programs, he/she receives value/points for viewing the commercial.

As to “to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file” Shintani discloses (col.4, lines 33-40) that the viewer is able to watch the pay program by using his number of points collected by viewing commercials.

As to “wherein said device comprises an automatic control module for ordering downloading via said network to a storage space accessible to said receiver, of portions of said file, designed to order the downloading of each of

said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said portion” Shintani discloses (col.4, lines 19-44) that the viewer earns points by viewing commercials. When viewer earns enough points, he can order a pay program to watch, where his points are reduced for watching this pay program. Viewer can continue and watch another pay program using his points until he runs out of points value as represented in Fig. 2.

Shintani meets all the limitations of the claim except “programs are being stored in a receiver's memory.” However, Herz discloses (col.45, lines 52-60) that the program list indicating those video programs based on the user preference is stored in memory of the set-top box as represented in Fig. 9 (element 902). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Shintani's system by receiving and storing viewer's preferred programs in the storage unit of the receiver as taught by Herz in order to easily access these programs at user's convenient time.

Regarding **claim 16**, “acquisition device for obtaining files wherein it comprises a module for prior selection of at least one content by said user, said downloaded file carrying said content” Herz discloses (col.4, lines 20-30; col.38, lines 16-20) that server transmits programming data to receiver based on the user's preference profile where user pre-selects his favorite movies/programs to

Art Unit: 2425

watch. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Shintani's system by pre-selecting programs user would like to view as taught by Herz in order to eliminate channel surfing and going through all the trouble to find a program suitable for viewing (col.1, lines 45-46).

Regarding **claim 20**, "acquisition device for obtaining files wherein it comprises a module for recording the aggregate number of points in respect of the acquisition of each of said files and a module for communicating said aggregate number to said user" Shintani discloses (col.4, lines 20-22) that the smart card stores the total number of points earned by the user and displays it on the display device to the user as represented in Fig. 4.

Regarding **claim 21**, "acquisition device for obtaining files wherein the ratio of sizes of each of said portions of file with respect to said file is equal to the ratio of the number of points of said fraction associated with said portion with respect to said predetermined level for said file" Herz discloses (col.25, lines 17-29) that based on agreement matrix created from user profile, programs with the highest value and the closest match to user's profile are prioritized and transmitted to the receiver. In addition, the same motivation is used as rejection to claim 15.

Regarding **claim 22**, "acquisition device for obtaining files wherein the automatic control module is designed to order said downloading on each of said occurrences" Shintani discloses (col.4, lines 19-57) that based on the total points accumulated by receiving commercial programs, viewer can watch number of pay programs.

Regarding **claim 23**, "acquisition device for obtaining files wherein the automatic control module is designed to order the downloading of files of at least one of the following types: MPEG video files and MP3 audio files" Shintani discloses (col.2, lines 40-42) that the MPEG decoder in the receiver receives MPEG video data.

Regarding **claim 24**, "acquisition device for obtaining files wherein it comprises a module for detecting said occurrences" Shintani discloses (col.3, lines 23-26) that the receiving device determines a receiving of commercial programs as represented in Fig. 2 (element S1).

Regarding **claim 25**, "acquisition device for obtaining files wherein said operations are chosen from at least one of the following operations: viewing of advertisements, listening to advertisements, consulting of Internet sites and responses to questionnaires by telecommunication" Shintani discloses (col.5,

lines 20-22, 44-46; col.7, lines 8-9) that the viewer earn points by responding to questionnaire performed via the commercial programs.

Regarding **claim 26**, “acquisition process for obtaining files by accumulating points, in which a user of a receiver of data of a communication network earns points by accomplishing at least one predefined operation” reads on the device that displays commercial, where viewers earn points for watching commercials (abstract) disclosed by Shintani and represented in Fig. 2. Shintani discloses (col.3, lines 54-59) that when viewer responds to the commercial programs, he/she receives value/points for viewing the commercial.

As to “acquires at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file” Shintani discloses (col.4, lines 33-40) that the viewer is able to watch the pay program by using his number of points collected by viewing commercials.

As to “wherein a downloading via said network to a storage space accessible to said receiver, of portions of said file is ordered automatically by ordering the downloading of each of said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said portion” Shintani discloses (col.4, lines 19-44) that the viewer earns points by viewing commercials. When viewer earns enough points, he can order a pay program to watch, where his points are reduced for watching this pay



program. Viewer can continue and watch another pay program using his points until he runs out of points value as represented in Fig. 2.

Shintani meets all the limitations of the claim except "programs are being stored in a receiver's memory." However, Herz discloses (col.45, lines 52-60) that the program list indicating those video programs based on the user preference is stored in memory of the set-top box as represented in Fig. 9 (element 902). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Shintani's system by receiving and storing viewer's preferred programs in the storage unit of the receiver as taught by Herz in order to easily access these programs at user's convenient time.

Regarding **claim 27**, "interactive terminal wherein it comprises an acquisition device for obtaining files" Shintani discloses (col.2, lines 26-28) the digital television broadcasting receiving device where the invention is applied as represented in Fig. 1.

Regarding **claim 29**, use the same rejection as rejected to claim 26 and "computer program product comprising a computer useable medium having a computer readable program, wherein the computer readable program when executed on a computer causes the computer to" Herz discloses (col.50, lines 6-

7) that the method of the invention can be implemented in a personal computer as represented in Fig. 11.

6. **Claims 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shintani in view of Herz as applied to claim 15 above, and further in view of US Publication 2003/0167205 A1 to Maruyama et al (hereafter referenced as Maruyama).

Regarding **claim 17**, "acquisition device for obtaining files wherein the module for prior selection allows said user to select at least two contents" Herz discloses (col.4, lines 25-27) that one or more channels data are determined based on the user profile's agreement matrix.

Combination of Shintani and Herz meets all the limitations of the claim except "said device comprises a module for apportioning said points earned into at least two accounts associated respectively with contents." However, Maruyama discloses (¶0077) that the user applies his/her accumulated points to purchase an item A and uses the remaining point to purchase a second item B as represented in Fig. 16. Maruyama further discloses (¶0097) that the points are easily utilized to receive multiple services as represented in Fig. 12. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to share points to purchase multiple items as taught by Maruyama in order to provide various premiums by accumulation of these points to thereby realize repetitive utilization (¶0003).

Regarding **claim 18**, “acquisition device for obtaining files wherein it comprises a module for allocating priority designed to permit said user to choose an order of priority of assignment of the points earned to said accounts” Herz discloses (col.25, lines 17-29) that the agreement matrix prioritized programs based on the closest match to the user profile. In addition, the same motivation is used as rejection to claim 15.

Regarding **claim 19**, “acquisition device for obtaining files wherein the apportioning module is designed to assign the points earned to the account benefiting from the highest priority, and when the aggregate number of points in respect of the account benefiting from the highest priority reaches said predetermined level, to assign the additional points earned to the accounts having lower priorities, according to said order of priority” Herz discloses (col.25, lines 17-29; col.30, lines 41-46) that based on the importance given to a certain movie or a program by customer, server updates agreement matrix and transmits prioritized programs to the receiver. In addition, the same motivation is used as rejection to claim 15.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PINKAL CHOKSHI whose telephone number is (571)

Art Unit: 2425

270-3317. The examiner can normally be reached on Monday-Friday 8 - 5 pm (Alt. Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C./

Examiner, Art Unit 2425

/Brian T. Pendleton/

Supervisory Patent Examiner, Art Unit 2425